[redacted]

IN THE

Supreme Court of the United States

October Term, 1934.

No. [redacted] 194

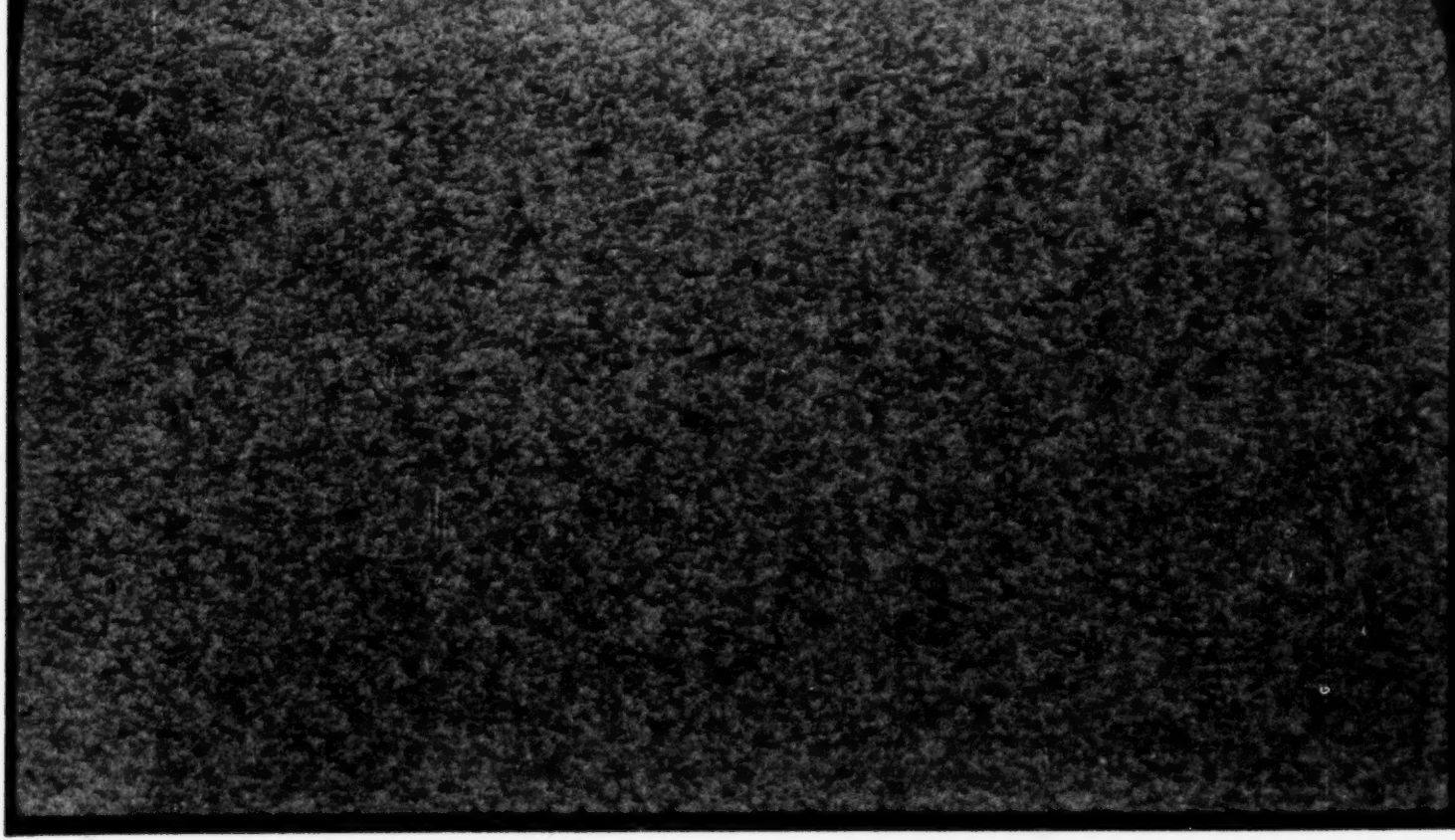
[redacted]

BRIEF FOR RESPONDENT IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI.

[redacted]

Counsel for Respondent.

[redacted]



SUBJECT-MATTER INDEX.

Page

1. Statement of Case 1

2. Summary of Argument 5

3. Argument:

(a) Point I. This case presents no public, special, or important question, or any question of the character which Rule 35 of this court indicates will be considered as a reason for granting a writ of certiorari 5

(b) Point II. Petitioner is not in a position to complain of the enforcement of Equity Rule 75 by the Circuit Court of Appeals because in November, 1925, it was notified of the respondent's position that the evidence could not be considered by that court on account of the non-compliance with that rule, and it made no effort to comply with it, but, on the contrary, sought to evade the same by having the judge of the District Court order all the evidence reproduced in the exact words of the witnesses, and not in narrative form 12

4. Conclusion 15

CASES CITED.

Houston v. Southwestern Bell Telephone Co., 259 U. S. 318 6

Newton v. Consolidated Gas Co., 258 U. S. 165 6

Patterson v. Mobile Gas Co., 271 U. S. 131 6

Re. Semaphoric Indicator Company 11

R. W. Clark Manufacturing Co. v. Tablet & Ticket Co. 11

United States v. Adams, 9 Wall. 554 13

United States v. Motion Picture Patents Co., 230 Fed. 531 8

IN THE

Supreme Court of the United States

OCTOBER TERM, 1926.

No. 969.

BARBER ASPHALT PAVING COMPANY, *Petitioner*,

vs.

STANDARD ASPHALT AND RUBBER COMPANY, *Respondent*.

BRIEF FOR RESPONDENT IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI.

STATEMENT OF THE CASE.

This is an ordinary patent infringement case, which was begun February 2, 1915 (Rec. p. 7). An interlocutory decree was entered on February 20, 1917 (Rec. p. 1217), and a final decree on April 30, 1924 (Rec. p. 4676).

An appeal was allowed and citation issued on July 1, 1924 (Rec. p. 4684). Twelve 30-day extensions of time for filing the record in the Court of Appeals were granted (Rec. pp. 4877-4882), the last expiring on July

26, 1925. One copy of the transcript of the record was filed in the Circuit Court of Appeals on July 3, 1925. The required additional copies were not filed and served, however, until November 2, 1925. The transcript did not comply with Equity Rule 75, in that the evidence was set forth in full—the testimony of the witnesses not being in narrative form—and there was no certificate of the judge of the court below.

On November 9, 1925—one week after a copy of the record was served on respondent—the latter raised the question as to whether the evidence and testimony should not be stricken from the record and disregarded by the court, because of the lack of the said certificate, and because the evidence had not been stated in simple and condensed form, but in full, and the testimony of witnesses had not been reduced to narrative form (Rec. pp. 4967-4970). The latter question was specifically raised in the following language (Rec. p. 4970):

> "4. The purported evidence appearing in the purported transcript of the record filed herein is not stated in simple and condensed form and the purported testimony of witnesses is not stated in narrative form, but on the contrary thereof, said purported evidence and testimony is set forth in full, all contrary to Rule 75 of the Rules of Courts of Equity of the United States, and because and in consequence thereof all of said evidence and testimony should be stricken from the purported transcript of the record in said cause and disregarded by this Court."

On January 4, 1926, the petitioner filed a motion in the Circuit Court of Appeals for an order remitting the transcript of record to the District Court for the purpose of permitting that court "to append its Cer-

tificate of Evidence to that part of the record which sets forth the testimony and other evidence and proceedings had and taken before the said District Court," etc. (Rec. p. 4978.)

On January 29, 1926, the Circuit Court of Appeals granted the petitioner's motion for the remission of the transcript of record (Rec. p. 4985).

A month and a half thereafter (March 18, 1926), the petitioner made a motion in the District Court to have that court "append its Certificate of Evidence to that part of the record which sets forth the testimony and other proceedings had and taken before the said District Court on the trial of this cause, and for such further amendment, correction, or amplification as your Honor may see fit to make respecting the certification of the record, * * *" (Rec. p. 4909).

On March 30, 1926, the District Court made an order containing, among others, the following provision:

> "*And upon the request of the said Defendant, the said Barber Asphalt Paving Company,* the Court hereby directs that *all the testimony* in this cause be reproduced in the exact words of the witnesses, and not in narrative form." (Rec. pp. 4913-4915.)

The clerk of the District Court (not the judge) thereupon, on April 7, 1926, attached his certificate to the transcript of the record, consisting of ten printed volumes (Rec. p. 4959).

On April 13, 1926 (Rec. p. 4987) the argument of the case was set for April 29, 1926, but on April 22nd, on motion of petitioner, the argument was carried over until October 6, 1926 (Rec. p. 4988).

On the latter date, respondent moved to dismiss the

appeal for the reasons set forth in its motion of November 9, 1925, and upon the further ground that the record did not contain a number of the exhibits which it had offered in evidence (Rec. p. 4989). This motion was heard, as was also the case on its merits, on that day (Rec. p. 4991).

On December 13th, the Circuit Court of Appeals handed down its decision, to the effect that the evidence was not properly before it, and that therefore the decree should be affirmed (Rec., pp. 4992-4998). The opinion of the court reviews the facts and decisions thoroughly.

On December 31, 1926, petitioner presented a petition for rehearing and a motion to vacate the order of affirmance, and for an order "permitting the District Court for the Southern District of Illinois to *now* entertain procedure in accordance with Rule 75 (b) to bring about a statement of the evidence in this cause in simple and narrative form" (Rec. pp. 4999-5048). This motion was opposed by respondent (Rec. pp. 5051-5132) and on January 24, 1927, was denied (Rec. p. 5132).

Over twelve years have expired since the suit was begun, ten years since the interlocutory decree was made, and nearly three years since the final decree was entered.

The record is in ten volumes and contains 5139 printed pages.

SUMMARY OF ARGUMENT.

I.

This case presents no public, special, or important question, or any question of the character which Rule 35 of this court indicates will be considered as a reason for granting a writ of certiorari.

II.

Petitioner is not in a position to complain of the enforcement of Equity Rule 75 by the Circuit Court of Appeals because in November, 1925, it was notified of the respondent's position that the evidence could not be considered by that court on account of the non-compliance with that rule, and it made no effort to comply with it, but, on the contrary, sought to evade the same by having the judge of the District Court order all the evidence reproduced in the exact words of the witnesses, and not in narrative form.

ARGUMENT.

POINT I.

THIS CASE PRESENTS NO PUBLIC, SPECIAL, OR IMPORTANT QUESTION, OR ANY QUESTION OF A CHARACTER WHICH RULE 35 OF THIS COURT INDICATES WILL BE CONSIDERED AS A REASON FOR GRANTING A WRIT OF CERTIORARI.

Four reasons are advanced in the petition and supporting brief for the allowance of the writ. None of them, we submit, are of the character which this court

has indicated, in Rule 35 (5), are sufficient for that purpose. We will briefly discuss them.

(a) The first reason (Point I of the brief) is that the Circuit Court of Appeals has decided an important question of federal law which has not been, but should be, settled by this court. *The question is not stated.*

If the question is whether Rule 75 shall be enforced, or if it is whether the appellate court may decline to consider a record not made up in compliance with this rule, it has been answered by this court in the affirmative.

It is conceded that the equity rules have the force of statutes and that Circuit Courts of Appeals and District Courts have no power to dispense with them. It is not denied that the transcript of record in the case at bar is in direct conflict with that part of Equity Rule 75(b) which provides that

> "The evidence to be included in the record *shall not* be set *forth in full* * * * the testimony of witnesses being stated *only* in narrative form * * *"

In *Newton v. Consolidated Gas Co.*, 258 U. S. 165, this court admonished counsel to observe the rule and the courts "to enforce performance of this plain duty" and stated that the failure so to do might in the future result in "the dismissal of the appeal."

In *Houston v. Southwestern Bell Telephone Co.*, 259 U. S. 318, this court actually declined to consider an assignment of error because of the failure to observe Equity Rule 75(b), and Supreme Court Rule 21.

In *Patterson v. Mobile Gas Co.*, 271 U. S. 131, 132, Mr. Justice McReynolds said:

> "The record in this cause has been made up with such disregard of the rules that we cannot undertake to examine the evidence or to discuss

seriatim the thirty-four jumbled assignments of error. *It would be permissible to dismiss the appeal* (Newton v. Consolidated Gas Company, 255 U. S. 165, 174);"

The compliance by a Circuit Court of Appeals with the instructions of this court, and in the exact manner pointed out by this court, can hardly be a reason for the allowance of a writ of certiorari.

There is a suggestion in petitioner's brief that there is a variance among the Circuit Courts of Appeals as to requiring compliance with Equity Rule 75(b). Even if this were so, it would not present a question which this court has indicated in Rule 35 would be a ground for granting a writ of certiorari. That one Circuit Court of Appeals insists upon compliance with Rule 75(b) and another dispenses therewith does not present a case of conflict of decision between different Circuit Courts of Appeals.

(b) The second reason (Point II of the brief) is that because the District Court, after the question had been raised in the Circuit Court of Appeals, directed, *on the request of the petitioner*, that "*all the testimony*" be reproduced in the exact words of the witnesses and not in narrative form, the Circuit Court of Appeals was without power to do the very thing which, as before stated, this court in two cases had indicated should be done, and in one case actually did do, for failure to comply with Equity Rule 75(b). The mere statement of this proposition furnishes its refutation. Surely the rules of practice in equity causes which were promulgated by this court cannot be circumvented so easily. As stated by the Circuit Court of Appeals in the case at bar:

"The order is not in harmony with the spirit of Rule 75."

There is a vast difference between ordering the reproduction of various parts of the testimony in the exact words of the witnesses as Rule 75(b) permits and in attempting to circumvent, and thus nullify, the rule by directing reproduction of *all* of the testimony. The latter is exactly what the rule says shall not be done.

In *U. S. v. Motion Pictures Patents Company*, 230 Fed. 531, cited in petitioner's brief, the court passed upon this very proposition and said (page 542):

> "To apply the exception, under which any part of the testimony may be set forth in full, to the whole testimony, would be an evasion of the duty imposed by the rule."

Equity Rule 76 is also invoked under this point. It manifestly has no application to a situation such as is presented in this case. Nothing was "omitted" from the transcript of the record "by accident or error." At first petitioner made no effort whatsoever to comply with Rule 75. When it was notified that the respondent's position was that it had not complied with that rule and that therefore the Circuit Court of Appeals should not consider the evidence, it did not, even then, attempt to comply with the Rule, but on the contrary sought to evade it by having the District Judge do that which the rule expressly forbids. It gambled that it could circumvent the rule. It lost, and now after nearly a year and a half has expired since its attention was called to the fact that the record was not in accordance with the rule, it cannot be heard to invoke Rule 76.

Moreover, the latter rule has no application to a case of this kind because it only applies to cases where something has been *omitted* from the record.

(c) The third reason, in connection with Point III of the brief, presents two propositions;

(1) It is contended that the Act of February 26, 1919 (40 Stat. L., 1181) compels the Circuit Courts of Appeals to decide cases upon their merits, notwithstanding the transcript of the record is made up contrary to the express direction of Equity Rule 75.

If that Act is to be interpreted as argued by petitioner, then the rules of this court and the Circuit Courts of Appeal relating to the character of the records and briefs, such as Rule 25 of this court, are of no effect.

It is manifest, however, that this court has not considered the Act as Applicable to cases where there is a failure to comply with Equity Rule 75. (Newton v. Consolidated Gas Company, *supra;* Houston v. Southwestern Bell Telephone Company, *supra;* Patterson v. Mobile Gas Company, *supra.*)

All of these cases were heard and decided subsequent to the Approval of the Act in question.

(2) It is next urged that the most an appellate court can do, where Equity Rule 75 has been flagrantly disregarded, is to impose costs upon the appellant.

A full answer to this argument is found in what this court said and did respectively in the before cited cases.

Notwithstanding petitioner has argued that the Circuit Courts of Appeals could ignore Rule 75, it now argues that the equity rules are absolutely binding upon them, and that consequently, the only remedy which can be applied by those courts for an infraction of Equity Rule 75 is that provided by Equity Rule 76 *i. e.*, imposition of costs.

In order to escape the contrary effect of what was said and done by this court in the cases before cited,

petitioner suggests that this Court has power to waive, or modify, the equity rules, and presumably did so in the cases last cited; in other words, this court may grant a different and far more drastic remedy than the Circuit Courts of Appeals. The rules, however, make no distinction as to the remedies which may be granted by the different appellate courts, and no reason is suggested as to why there should be any difference.

Moreover, if Rule 76 is applicable to violations of Rule 75, (which is denied) the remedy provided in Rule 76 is not exclusive, and we think that this court has so determined in the cases before cited. It is not to be presumed that this court would have refused to consider evidence in Houston vs. Southwestern Bell Telephone Company, if the only remedy contemplated for the infraction of the rule there complained of was that provided for in Rule 76.

(d) The fourth and last reason (Point IV of the brief) is that the appellate court did not exercise a "sound discretion" in doing what this court indicated it might itself do, and what it afterwards did do in a like situation.

But quite apart from this, the failure to exercise a "sound discretion" is not reversible error; much less is it a ground for the issuance of a writ of certiorari by this court. It is not claimed that there was a *clear abuse* of discretion. No such argument could have been advanced under the circumstances of this case.

The main reason urged in support of the contention that there was a failure to exercise a "sound discretion" is that the Court of Appeals for the Seventh Circuit had not previously required a strict compliance with Equity Rule 75.

Reference is made to an examination which was made

"immediately preceding the filing of the petition for rehearing" of the records in that Circuit Court of Appeals in other cases. We are not advised of the circumstances under which the transcripts of record were made up in those cases. It may very well be that counsel in those cases stipulated that the evidence should be reproduced in full and not in narrative form. A vastly different situation is present in the case at bar.

Whatever the petitioner may have been advised has been the practice in the Seventh Circuit, is of no materiality, because a year before the case was argued petitioner's attention was expressly directed to the fact that the respondent would contend that the court should not consider the evidence in the transcript of the record, because it did not comply with Rule 75. In the face of this objection the petitioner did not attempt to comply with Rule 75, but sought to evade it.

It would appear that petitioner also complains that the court elected to commence the strict enforcement of this rule against petitioner, rather than against some other appellant.

There would appear to be much less reason for favorably considering this petition than for favorably considering the petition to this court for a mandamus by *Semaphoric Indicator Company and Semaphoric Indicator Sales Company*, which was denied by this court on February 28, 1927. As appears from the petition filed in this court, the appeal in that case was dismissed for failure to observe Rule 75 (b), notwithstanding that the trial judge and all counsel agreed that the transcript of the record should contain the evidence in full.

The dissenting opinion of Judge Alschuler in *R. W. Clark Manufacturing Company vs. Tablet and Ticket Company*, printed in full as Appendix D to petitioner's

brief, points out the distinction between the case at bar and other cases in which the Circuit Court of Appeals of the Seventh Circuit refused to consider transcripts which were not made up in compliance with Rule 75, as follows:

> "While in Barber Asphalt the appellee *insistently moved and urged dismissal of the appeal because of noncompliance with the rule*, in this case, as in most, if not all the others, the transcript was prepared under stipulation of counsel for all parties, and consent of the trial judge."

POINT II.

PETITIONER IS NOT IN A POSITION TO COMPLAIN OF THE ENFORCEMENT OF EQUITY RULE 75 BY THE CIRCUIT COURT OF APPEALS, BECAUSE IN NOVEMBER, 1925, IT WAS NOTIFIED OF THE RESPONDENT'S POSITION THAT THE EVIDENCE COULD NOT BE CONSIDERED BY THAT COURT ON ACCOUNT OF THE NON-COMPLIANCE WITH THAT RULE, AND IT MADE NO EFFORT TO COMPLY WITH IT, BUT ON THE CONTRARY, SOUGHT TO EVADE THE SAME BY HAVING THE JUDGE OF THE DISTRICT COURT ORDER ALL THE EVIDENCE REPRODUCED IN THE EXACT WORDS OF THE WITNESSES, AND NOT IN NARRATIVE FORM.

Even if the court should be of the opinion that the refusal of a Circuit Court of Appeals to consider a transcript of record not made up in accordance with Equity Rule 75 (b) is a sufficient reason for issuing a writ of certiorari in a case where an appellant had

innocently failed to comply with the rule, that would not help the petitioner here, because of the peculiar circumstances and facts of this case.

As before pointed out, the petitioner was notified within a week after a copy of the transcript of the record was served upon respondent that it was the latter's position that the Circuit Court of Appeals should not consider the evidence, because the record was not made up in accordance with the rule. Petitioner took no action for two months, and then applied for and procured an order remitting the transcript of the record to the District Court. It waited for nearly two months more before taking any action in that court. It then did not seek to comply with, but to circumvent the rule by having the judge of the District Court direct that "*all the testimony* be reproduced in the exact words of the witnesses." It was not until after the Circuit Court of Appeals had held that it would not consider the evidence in the condition in which it was presented, that it made any effort whatever to comply with the rule. In the meanwhile, over a year had expired since its attention was first called to the infraction of the rule and to the respondent's position in respect thereto. The remarks of Mr. Justice Nelson in United States vs. Adams, 9 Wall., 554, are strikingly applicable to this phase of the case. He said:—

> "The remedy, in case the Court of Claims falls into a mistake as to the finding of the facts, is familiar. It is by an application to this court to remit the case back for correction, if it be shown, satisfactorily, that a mistake has been committed.
>
> "In the case before us, it is admitted that the mistake was known to the party and his counsel in season to have had it corrected before hearing;

but, relying on its immateriality, no step was taken to have the correction made. We do not doubt but that this opinion was honestly entertained, and that this motion is made in good faith; but it is impossible not to see that, if granted, the precedent might lead to great abuse and delay in the hearing of these cases. We should allow either party to lie by till the cause was decided and the opinion delivered, and then to apply for the correction, as the exigency of the case might require, or as the materiality of the fact might appear from the ground upon which the decision was placed. On an appeal, the parties were entitled to have all the facts proved in the case before the court below, in the judgment of the court, truly found, and stated in the record, that either deemed material to the decision; and, as we have seen, the remedy is ample to correct any mistakes committed, if applied for prior to the hearing in this court. The court is not willing to go further, and permit the remedy to be applied after the case is heard and decided, as we fear that such a precedent would work greater injustice and hardship, in its general use and application, that that which may exist in any particular case."

This litigation has lasted over 12 years. More than 10 years have elapsed since the interlocutory decree was made, and nearly 3 years since the final decree was entered.

The petitioner has been found guilty of infringement. During all this time the respondent has been deprived of the money which the final decree adjudged that it was entitled to receive. Surely under these circumstances the discretion of this court should not be exercised in favor of a petitioner who has flagrantly ignored and then attempted to circumvent, over the objection of the respondent, a rule of practice which

this court has considered so important as to justify it in refusing to consider a record not made up in accordance therewith.

CONCLUSION.

It is respectfully submitted that the petition for a writ of certiorari should be denied.

Respectfully submitted,

ALEXANDER F. REICHMANN,
THOMAS G. HAIGHT,
FRANK L. BELKNAP,
WILLIAM F. HALL,
Counsel for Respondent.